REMARKS

After entry of the subject Amendment and Response, claims 4-29 and 37-40 remain pending in the subject Reissue application with claims 4, 18, 19, 20, and 37 being in independent form. The following remarks outline the various rejections and objections made by the Examiner. Applicant respectfully submits that each of the rejections and objections has been overcome such that the subject Reissue application is in a condition for allowance.

Objection to the Claims

The Examiner has noted that the numerous interlineations and/or cancellations to the claims could lead to confusion and mistake during the issue and printing processes. Accordingly, the Examiner is requesting that all of the pending claims be rewritten.

Attached herewith, at Tab 1, is a Claim Appendix with Markings to Show Changes Made, which sets forth each of the claims including any deletions and additions. Further, for the Examiner's convenience, attached at Tab 2 is a Claim Appendix without Markings, which sets forth each of the claims as they currently stand in the subject application. Applicant respectfully submits that this request has been satisfied.

Withdrawn Claims

The Examiner has withdrawn claims 30-36 from consideration as being directed to a non-elected invention. In particular, the Examiner has denied Applicant's request to allow the method claims to remain the subject application. In order to streamline the allowance of the subject Reissue application, Applicant has expressly cancelled these claims.

Reissue Oath/Declaration

The Examiner notes that the current oath/declaration is defective because it does not cover all of the amendments made in the subject Reissue application. The Examiner has formally rejected claims 4-29 and 37-40 based upon a defective reissue declaration under 35 U.S.C. § 251. The Examiner recognizes that an appropriate supplemental declaration under 37 CFR § 1.175(b)(1) will overcome this rejection.

Applicant hereby submits an appropriate Second Supplemental Reissue Declaration, at Tab 3, which incorporates the acceptable language suggested by the Examiner. Accordingly, this rejection of the claims is believed overcome.

Litigation Status

The Examiner notes that the patent sought to be reissued, which is U.S. Patent No. 5,653,148 (the '148 patent) has been involved in litigation. The Examiner also states that any documents and/or materials which would be material to the patentability of this Reissue application are required to be made of record in this response.

Applicant notes that all such documents and/or materials relating to the patentability of this Reissue application have been previously submitted. In addition, Applicant hereby updates the Examiner that during the appeal period, the '148 patent was dismissed from the litigation. Enclosed herewith, at Tab 4, is a Judgement from the U.S. District Court for the Eastern District of Michigan ordering that a motion for Summary Judgement of non-infringement of the '148 patent be GRANTED. The judgement is dated September 13, 2000. Accordingly, as of September 13, 2000, the '148 patent was no longer in litigation and the expedited procedures set forth in MPEP 1442.01 - 1142.05 are no longer applicable.

Objection to the Drawings

The Examiner has objected to the drawings on the grounds that the following claimed features are not shown;

a) the overall length of the first and second conduit sections;

b) the shortening of the overall length of the first and second conduit sections;

c) the shortest overall length of the conduit;

d) the locking member that is abutted with the spring.

In response to this objection, Applicant has renumbered original Figure 3 to Figure 3A and has added Figure 3B, see enclosed drawing sheets at Tab 5. Figure 3A illustrates the shortest overall length of first and second conduit sections. Figure 3B illustrates an

intermediate lengthened position of the first and second conduit sections. In addition, Applicant provides the following responses to each of the drawing objections;

a) the overall length of the first and second conduit sections is not being claimed. Instead, the coil spring biasing the members or components together to shorten the overall length of the first and second conduit sections is being claimed. Figures 3A and 3B show the coil spring biasing the members or components together to shorten the overall length of the first and second conduit sections;

b) the shortening of the overall length of the first and second conduit sections is clearly illustrated by the dimensional differences between Figures 3A and 3B;

c) the shortest overall length of the first and second conduit sections is shown in Figure 3A;

d) Figures 3A, 3B, 4, and 6 clearly illustrate that the locking member (19) reacts with the spring (22) as claimed. The Examiner is inaccurate in characterizing the reaction between the locking member (19) and spring (22) as being an abutment. The Board of Patent Appeals and Interferences agrees with the Applicant that the locking member clearly *reacts* with the spring, see Page 4, second full paragraph of the Decision on Appeal. In particular, the Board states;

> We first note that the **claim does not require that the locking member abut with the spring**, as the examiner has stated, but that it define an abutment that "reacts" with the spring. . . . it is our view that one of ordinary skill in the art would have understood from a perusal of the specification and drawings that a face of locking member 19 abuts collar 26, which in turn is in contact with spring 22 and therefore, as claimed, the locking member defines an abutment that "reacts" with the spring (emphasis added).

In light of the above discussion, Applicant submits that Figures 3A and 3B clearly illustrate the claimed features noted by the Examiner and/or the Examiner is incorrect in objecting to the drawings. As such, the current drawing objections are believed overcome. Applicant has amended the specification in accordance with these drawing changes. A Version of Specification with Markings to Show Changes Made is attached at Tab 6.

The Recapture Rejection

The Reissue application is necessary to remove the mistake in the use of the term "in tension" as it is applied to the spring. The mindset was that the conduit sections are placed "in tension" during the shortening of the overall length thereof and the mistake was made by applying the term "in tension" to the spring. In fact, the spring in the embodiment illustrated in the application is NOT "in tension", it is in compression. It cannot be recapture to correct an obvious error.

Decision by the Board of Patent Appeals and Interferences

The Board of Appeals, in its decision mailed March 29, 2002, expressly recognized that the reissue claims removed the term "in tension" and found invention in "the spring to bias the adjustment components 'together' in the direction to shorten the overall length of said conduit sections" (emphasis added).

The Board found that the references teach lengthening the overall length, "rather than shorten it as is required by" the appealed claims. The Board found invention in the combination of a spring to bias and shorten the overall length of the conduit sections.

1213.02 New Grounds of Rejection by Board

> Under 37 CFR 1.196(b), the Board may, in its decision, make a new rejection of one or more of any of the claims pending in the case, including claims which have been allowed by the examiner.

The Board is very experienced and could have used its expertise to make a new rejection based on recapture had it deemed it applicable. However, the Board recognized the removal of the term "in tension" as a basis for a broadening Reissue application and did not make such a recapture rejection.

Res Judicata

707.07(g) Piecemeal Examination

> Piecemeal examination should be avoided as much as possible. The examiner ordinarily should reject each claim on all valid grounds available, avoiding, however, undue multiplication of references. (See MPEP § 904.03) Major technical rejections on grounds such as lack of proper disclosure, lack of enablement, serious indefiniteness and res judicata should be applied where appropriate even though there may be a seemingly sufficient rejection on the basis of prior art. Where a major technical rejection is proper, it should be stated with a full development of reasons rather than by a mere conclusion coupled with some stereotyped expression.

Since the issue of recapture should have been raised in the rejection before the appeal to the Board, the Examiner should be estopped from raising the issue at this late date on the grounds of res judicata and against the mandate of the MPEP.

Recapture

Claims 4-29 and 37-40 stand rejected under 35 U.S.C. § 251 as being an improper recapture of broadened claimed subject matter surrendered in the application for the patent upon which the present Reissue application is based. In particular, the Examiner contends that the spring being *in tension* is why the claims were allowed in the parent application not withstanding the fact that the Board of Appeals has allowed these claims over the prior art without the term "in tension". The Examiner merely concludes that "to remove this limitation in the reissue claims is recapture".

Applicant respectfully disagrees with the Examiner's statements regarding the reasons for allowance of the parent application. Upon a review of the file history of the parent application, it is clear that the patent issued due to the following unique combination;

- first and second conduit sections being in telescoping relationship with each other,
- a coil spring interacting between the adjustment components, and
- the adjustment components being biased together by the spring to shorten the overall length of the first and second conduit sections.

The patentability of the parent application had nothing to do with the term "in tension".

This term "in tension" was mistakenly applied to the spring instead of to the conduit sections. The mental mistake derived from the fact that during the shortening of the conduit sections, it is the conduit sections that are in tension, not the spring. The term "in tension" is inaccurate as the coil spring illustrated does not actually act in tension. In the embodiment illustrated, the spring acts in compression to place the conduit sections in tension as the overall length is shortened. Even though the shortening of the conduit could be accomplished by a spring "in tension", such an embodiment is not set forth in the application. The Board inferentially recognized this by allowing a generic claim not specifying that the spring be in either compression or tension, just that the spring bias the conduit sections to shorten the overall length.

Applicant respectfully submits that the removal of the term "in tension" does NOT constitute recapture, but corrects an obvious error, which is inaccurate as applied to the illustrated embodiment. As stated above, the term "in tension" as applied to the spring per se, is not illustrated. In particular, the specification of the parent application preferably discusses the spring being in compression. Specifically, the following excerpts set forth the state of the spring;

> [A] retainer 24 is disposed on one of the telescoping members during assembly thereof for retaining the spring 22 in **compression** . . . (see Column 2, line 67 - Column 3, line 1) (emphasis added).
>
> . . . as the length of the conduit is increased . . . the sides of the locking member 19 will engage the collar 26 to **compress** the spring 22 . . . (see Column 4, lines 13-15) (emphasis added).

The term compress or compression means a state of the spring when the ends of the spring are biased together. As discussed in these sections and as shown in Figures 3A and 3B, this is clearly how the spring operates in the preferred embodiment of the application. In other words, the spring illustrated is in compression to place the conduit sections in tension to shorten the overall length. Recapture cannot apply to a term in the claims where that term should have been objected to as not readable upon the embodiment shown in the drawings.

MPEP 1412.02 sets forth a two step test for finding recapture. The first step in

applying the recapture rule is to determine whether and in what aspect the reissue claims are broader than the patent claims. The second step is to determine whether the broader aspects of the reissue claims relate to surrendered subject matter. To determine whether a particular subject matter is surrendered, one must look to the prosecution history for arguments and changes to the claims made in an effort to overcome a prior art rejection. As set forth above, the term "in tension" was NOT incorporated into claim 1 to overcome a prior art rejection per se. In other words, there was NOT a prior art patent having a spring acting "in compression" where the term "in tension" was argued to be patentably distinct. As recognized by the Board of Appeals the invention resides in the shortening of the overall length of the conduit sections. This does not require the spring to be "in tension" as the Board allowed claims supported by an embodiment wherein the spring is in compression. Accordingly, the term "in tension" is not a part of the surrendered subject matter to distinguish over the prior art.

As set forth in the Second Supplemental Reissue Declaration, the Inventor reinforces this interpretation of the "compression" and "in tension" terms. In particular, the inventor recognizes that it was a mistake to incorporate the term "in tension" into the claims when referring to the spring.

Applicant has set forth numerous reasons for why the removal of the term "in tension" does not constitute recapture. Accordingly, the recapture rejection of claims 4-29 and 37-40 is believed overcome.

It is therefore respectfully submitted that the Application, as amended, is now presented in condition for allowance, which allowance is respectfully solicited. The Commissioner is authorized to charge our Deposit Account No. 08-2789 for any fees or credit the account for any overpayment.

Respectfully submitted,

HOWARD & HOWARD ATTORNEYS, P.C.

December 20, 2002
Date

Samuel J. Haidle, Registration No. 42,619
The Pinehurst Office Center, Suite #101
39400 Woodward Avenue
Bloomfield Hills, MI 48304-5151
248) 723-0334

CERTIFICATE OF MAILING

I hereby certify that the attached **Amendment and Response** is being deposited with the United States Postal Service as first class mail, postage prepaid, in an envelope addressed to the **Assistant Commissioner for Patents, Washington, D.C. 20231**, on **December 20, 2002**.

Brenda J. Hughes

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Claim Appendix with Markings to Show Changes Made

[1. A motion transmitting remote control assembly (10) type for transmitting motion in a curved path, said assembly coming:

first (14) and second (16) conduit sections:

a flexible motion transmitting core element (12) movably supported in said conduit sections;

adjustment components (18, 20) interconnecting said first and second conduit sections (14, 16) and in telescoping relationship with each other for adjusting the overall length of said first and second conduit sections;

a coil spring (22) interacting [in tension] between said adjustment components (18, 20) to bias said components together to shorten the overall length of said first and second conduit sections (14, 16).]

[2. An assembly as set forth in claim 1 including a retainer (24) for retaining said spring (22) in compression on one of said telescoping members.]

[3. An assembly as set forth in claim 2 wherein said adjustment components include an abutment (19) for reacting with said spring (22) in place of said retainer (24) to bias said telescoping members together in the direction to shorten the overall length of said conduit sections.]

4. [An assembly as set forth in claim 3] A motion transmitting remote control assembly (10) for transmitting motion in a curved path, said assembly comprising:

a first (14) and second (16) conduit sections;

a flexible motion transmitting core element (12) movably supported in said conduit sections;

adjustment components (18, 20) interconnecting said first and second conduit sections (14, 16) and in telescoping relationship with each other for adjusting the overall

length of said first and second conduit sections (14, 16) wherein one of said adjustment components [said first telescoping member] is a female member (20) and the other of said adjustment components [said second telescoping member] is a male member (18) slidably disposed in said female member (20);

a coil spring (22) [said spring (22) being] supported on said male member (18) and interacting between said members (18, 20) to bias said members (18, 20) together to shorten the overall length of said first and second conduit sections (14, 16); and

a retainer (24) for retaining said spring (22) in compression on one of said members (18, 20), said members (18, 20) including an abutment (19) for reacting with said spring (22) in place of said retainer (24) to bias said members (18, 20) together in the direction to shorten the overall length of said conduit sections (14, 16).

5. An assembly as set forth in claim 4 wherein said male member (18) includes adjustment teeth (21) therealong and a locking member (19) supported by said female member (20) for engaging said teeth (21) in a locked position to prevent relative telescoping movement between engaging said teeth (21) in a locked position to prevent relative telescoping movement between said telescoping members (18 and 20), said abutment being presented by said locking member (19).

6. An assembly as set forth in claim 5 wherein said locking member (19) includes a tunnel (30) extending therethrough for receiving said retainer (24) through said tunnel (30) during telescoping movement of said male and female members (18 and 20) in the conduit lengthening direction to allow said abutment on said locking member (19) to react with said spring (22).

7. An assembly as set forth in claim 6 wherein said male and female member (18 and 20) include complementary keyways (38 and 40) for rotary orientation of said male member (18) relative to said female member (20).

8. An assembly as set forth in claim 7 wherein said spring (22) spiraled around said male member (18) and includes an annular collar (26) reacting axially between said retainer (24) and said spring (22) and for reacting between said spring (22) and said locking member (19).

9. An assembly as set forth in claim 8 wherein said male member (18) defines an inner end (32) and said female member (20) presents a bottom end wall (34), said retainer (24) presenting a reaction surface for reacting with said collar (26) and which reaction surface is axially spaced toward said bottom end wall (34) from said abutment presented by said locking member (19) when said inner end (32) of said male member (18) is fully inserted adjacent said bottom end wall (34) of said female member (20).

10. An assembly as set forth in claim 9 including a detent (27) for holding said locking member (19) in an intermediate position out of engagement with said teeth (21) while in engagement with said collar (26).

11. An assembly as set forth in claim 10 wherein said male member (18) includes a sealing length adjacent said inner end (32) thereof in sliding engagement with said female member (20) and a reduced cross section defining a spring seat (44) therebetween, said spring (22) reacting between said spring seat (44) and said collar (26).

12. An assembly as set forth in claim 11 including a seal (46) sealing said sealing length of said male member (18) and said female member (20).

13. An assembly as set forth in claim 12 including a pillar (36) extending into said female member (20) from said bottom end wall (34) thereof, said pillar (36) having a bore therethrough, said core element extending through said bore in said pillar (36).

14. An assembly as set forth in claim 13 wherein said keyways (38 and 40)

extend axially along the exterior of said pillar (36).

15. An assembly as set forth in claim 13 wherein said male member (18) presents an internal limit surface (42) for engaging the inner end (32) of said pillar (36) to limit the insertion of said male member (18) into said female member (20) to define the shortest overall length of said conduit.

16. An assembly as set forth in claim 13 wherein said locking member (19) is U-shaped with teeth (23) on the interior of said legs for engaging said teeth (21) on said male member (18) and hooks (25) at the distal ends of said legs, said detent (27) including recesses in said female member (20) for engaging said hooks (25) in said intermediate position, said female member (20) presenting catches (28) for engaging and retaining said hooks (25) to lock said locking member (19) in said locked position.

17. The motion transmitting remote control assembly (10) of claim 4 wherein said spring (22) expands axially to bias the components (18, 20) together to shorten the overall length of said first and second conduit section (14, 16).

18. A motion transmitting remote control assembly (10) for transmitting motion in a curved path, said assembly comprising:

a first (14) and second (16) conduit sections;

a flexible motion transmitting core element (12) movably supported in said conduit sections;

adjustment components (18, 20) interconnecting said first and second conduit sections (14, 16) and in telescoping relationship with each other for adjusting the overall length of said first and second conduit sections (14, 16) wherein one of said adjustment components includes adjustment teeth (21) and the other of said adjustment components supports a locking member (19) that selectively engages said teeth (21) to prevent relative telescoping movement between said adjustment components (18, 20); and

a coil spring (22) interacting between said adjustment components (18, 20) to bias said components (18, 20) together to shorten the overall length of said first and second conduit sections (14, 16).

19. A motion transmitting remote control assembly (10) for transmitting motion in a curved path, said assembly comprising:

a first (14) and second (16) conduit sections;

a flexible motion transmitting core element (12) movably supported in said conduit sections;

adjustment components (18, 20) interconnecting said first and second conduit sections (14, 16) and in telescoping relationship with each other for adjusting the overall length of said first and second conduit sections (14, 16);

a coil spring (22) interacting between said adjustment components (18, 20) to bias said components together to shorten the overall length of said first and second conduit sections (14, 16); and

a collar (26) supported on one of said adjustment components (18, 20) for reacting axially between said one of said adjustment components and said spring (22).

20. A motion transmitting remote control assembly (10) for transmitting motion in a curved path, said assembly comprising:

a first (14) and second (16) conduit sections;

a flexible motion transmitting core element (12) movably supported in said conduit sections;

adjustment components (18, 20) interconnecting said first and second conduit sections (14, 16) and in telescoping relationship with each other for adjusting the overall length of said first and second conduit sections (14, 16) wherein said adjustment components include a female member (20) and a male member (18) slidably disposed in said female member (20); and

a coil spring (22) supported on said male member (18) and interacting between said

members (18, 20) to bias said members (18, 20) together to shorten the overall length of said first and second conduit sections (14, 16).

21. An assembly as set forth in claim 20 including a retainer (24) disposed on one of said adjustment components (18, 20) for retaining said spring (22) in compression.

22. An assembly as set forth in claim 21 wherein said retainer (24) is formed as a projection on said male member (18).

23. An assembly as set forth in claim 20 including a locking member (19) supported by said female member (20) and movable between a locked position to prevent relative telescoping movement between the adjustment components (18, 20) and an unlocked position to allow relative telescoping movement between the adjustment components (18, 20).

24. An assembly as set forth in claim 23 wherein said male member (18) includes adjustment teeth (21) and said locking member (19) includes locking teeth (23) for selectively engaging said adjustment teeth (21) when said locking member (19) is moved to said locked position.

25. An assembly as set forth in claim 24 wherein said locking member (19) includes at least one detent (25) and said female member (20) includes at least one recess (27) for receiving said detent to hold said locking member (19) in said unlocked position while prohibiting relative movement between said female member (20) and said locking member (19).

26. An assembly as set forth in claim 25 wherein said female member (20) includes at least one catch (28) for engaging and retaining said detent (25) when said locking member (19) is moved to said locked position.

27. An assembly as set forth in claim 23 wherein said locking member (19) defines an abutment that reacts with said spring (22) during assembly of said male member (18) into said female member (20) such that said adjustment components (18, 20) are biased together to shorten the overall length of said conduit sections (14, 16).

28. An assembly as set forth in claim 20 wherein said male (18) and female (20) members includes complementary keyways (38, 40) for rotary orientation of the male member (18) relative to the female member (20).

29. An assembly as set forth in claim 28 including a retainer (24) formed on said male member (18) for retaining said spring (22) in compression and a locking member (19) supported on said female member (20), said locking member (19) being selectively engageable with said male member (18) to prevent relative movement between said male (18) and female (20) members wherein said keyways align said retainer (24) within said locking member (19) as said male member (18) is inserted into said female member (20).

[30. A method for adjusting the length of a motion transmitting remote control assembly **(10)** having first **(14)** and second **(16)** conduit sections, adjustment components **(18, 20)** interconnecting the first and second conduit sections **(14, 16)** and in telescoping relationship with each other, a coil spring **(22)** interacting between the adjustment components, and a locking member **(19)** supported on one of the adjustment components **(18, 20)** comprising the steps of:

(a) installing the motion transmitting remote control assembly **(10)** in a vehicle;

(b) biasing the adjustment components **(18, 20)** together to shorten the overall length of the first **(14)** and second **(16)** conduit sections after said step (a); and

(c) moving the locking member **(19)** to a locked position to prevent relative movement between the adjustment components **(18, 20)** subsequently to step (b).]

[31. A method as set forth in claim 30 wherein step (a) further includes the steps of providing the adjustment components as a male member **(18)** and a female member **(20)** and inserting the male member **(18)** into the female member **(20)**.]

[32. A method as set forth in claim 31 including the step of supporting the spring **(22)** on the male member **(18)**.]

[33. A method as set forth in claim 32 including the steps of providing a first spring seat **(44)** on the male member **(18)**, supporting a retainer **(24)** on the male member **(18)**, seating one end of the spring **(22)** on the first spring seat **(44)**, and reacting an opposing end of the spring **(22)** against the retainer **(24)**.]

[34. A method as set forth in claim 33 including the steps of forcing the spring **(22)** over the retainer **(24)** as the spring is installed onto the male member **(18)**, installing a collar **(26)** onto the male member **(18)** adjacent to the retainer **(24)**, and seating the spring **(22)** between the first spring seat **(44)** and the collar **(26)** prior to step (b).]

[35. A method as set forth in claim 32 including the steps of providing the locking member **(19)** with at least one detent **(25)** and the female member **(20)** with at least one recess **(27)**, installing the locking member **(19)** on the female member **(20)**, and retaining the locking member **(19)** on the female member **(20)** in an unlocked position by engaging the detent **(25)** in the recess **(27)** prior to step (c).]

[36. A method as set forth in claim 35 including the steps of providing the female member **(20)** with at least one catch **(28)** and retaining the detent **(25)** with the catch **(28)** when the locking member **(19)** is moved to the locked position during step (c).]

37. A motion transmitting remote control assembly (10) for transmitting motion in a curved path, said assembly comprising:

a first (14) and second (16) conduit sections;

a flexible motion transmitting core element (12) movably supported in said conduit sections;

adjustment components (18, 20) interconnecting said first and second conduit sections (14, 16) and in telescoping relationship with each other for adjusting the overall length of said first and second conduit sections (14, 16);

a pillar (36) extending into said adjustment components (18, 20) and having a bore therethrough for receiving said core element (12); and

a coil spring (22) interacting between said components (18, 20) to bias said components (18, 20) together to shorten the overall length of said first and second conduit sections (14, 16).

38. An assembly as set forth in claim 37 wherein said adjustment components include a female member (20) and a male member (18) slidably disposed in said female member (20) including complementary keyways (38, 40) for rotary orientation of the male member (18) relative to the female member (20).

39. An assembly as set forth in claim 38 wherein said male member (18) presents an internal limit surface (42) for engaging an inner end (32) of said pillar (36) to limit insertion of said male member (18) into said female member (20) to define the shortest overall length of said conduit.

40. An assembly as set forth in claim 37 wherein said adjustment components include a female member (20) and a male member (18) slidably disposed in said female member (20), said pillar (36) being slidably disposed in said male member (18).

Version of Specification with Markings to Show Changes Made

Columns 1-2, please replace the paragraph under the heading "BRIEF DESCRIPTION OF THE DRAWINGS" with the following;

Other advantages of the present invention will be readily appreciated as the same becomes better understood by reference to the following detailed description when considered in connection with the accompanying drawings wherein:

FIG. 1 is a perspective view of a preferred embodiment of the subject invention;

FIG. 2 is a cross sectional view taken substantially along line 2-2 of FIG.1;

FIG. 3A is a cross sectional view taken along line 3-3 of FIG. 1 with first and second conduit sections being in a shortened position;

FIG. 3B is a cross sectional view similar to FIG. 3A with the first and second conduit sections being in an intermediate lengthened position;

FIG. 4 is an exploded perspective view of the preferred embodiment;

FIG. 5 is a cross sectional view similar to FIG. 2 but showing the assembly in the shipping position;

FIG. 6 is a side elevational view of the male member of the preferred embodiment; and

FIG. 7 is a cross sectional view taken along line 7-7 of FIG. 3.